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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,320	02/18/2004	Mark W. Jolley	82421	9435

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EXAMINER

BASINGER, SHERMAN D

ART UNIT PAPER NUMBER

3617

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/781,320

Applicant(s)

JOLLEY, MARK W.

Examiner

Sherman D. Basinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Priority*

1. If applicant desires priority under 35 U.S.C. 119(e) based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. **This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet.** The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the

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prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

### ***Drawings***

2. Figure 12 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

3. Claim 8 is objected to because of the following informalities: in line 1 "surfboard" should be -board-. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 7, 9, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Sanson et al.

Sanson et al discloses a method of manufacturing what can be considered to be a board. In Sanson et al, the upper and lower sheets of material are 9 and 9'. Figure 4 shows the forming of the upper and lower sheets of material into an interior of a mold cavity. Column 5, lines 58-66 disclose filling the shell with an expandable material. The mold walls 3 and 3' prevent the shell from deforming during the filling.

With regard to claim 2, note clamps 7 and 7'.

The gasket of claim 3 is 13.

Claim 4 is clearly met by what is shown in figure 4.

With regard to claim 7, note the heating of the sheets in figure 2. Further, in figure 4, the sheets are shown as being forced against the cavity walls.

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With regard to claim 9, note column 6, lines 5-8.

Sanson et al also discloses a method of manufacturing an apparatus with means (vacuum pump) for forming at least two sheets 9 and 9' to the interior of a mold cavity formed by 3 and 3', means for filling the sheet with expandable material (see column 5, lines 58-66), and means, walls 3 and 3', for preventing the shell from substantially deforming during filling with the expandable material.

The apparatus formed by Sanson et al is considered to be a floatable board.

6. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Teraoka.

The polymer shell is shown in figure 15. The first and second sheets are 17. The bonded together perimeter is shown in figure 15. The core is the polyurethane in hollow portion 54. Due to the expansion of the polyurethane after it is injected into the hollow portion 54 it is considered to have residual compressive stresses providing structural rigidity to the shell.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teraoka.

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Teraoka discloses graphics in the form of letters disposed on the surface of the sheets contacting the surface of the mold. See column 4, lines 60-65. Such a surface of the sheet would contact core 26 of figure 15. The area in which foam 26 is located can also be an interior of the shell. With graphics such as letters on the surface of the sheet contacting the foam 26, the graphics would be disposed on the interior of the shell between the shell and the core. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to provide graphics in this area. Motivation to do so is to identify the material being used as the sheet, or to provide directions for injecting the foam.

9. Claims 5, 6, 8, 10-16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanson et al in view of Teraoka.

Sanson et al does not disclose blowing fluid as claimed in claim 5 nor providing pressure force as claimed in claim 8. Teraoka discloses blowing fluid as claimed in claim 5 or providing a pressure force as claimed in claim 8—see column 4, lines 60-65. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to blow fluid between the upper and lower sheets of Sanson et al in the manner taught by Teraoka for spacing at least a portion of the upper and lower sheets of the material apart. Motivation to do so is to mold the article precisely and faithfully according to the molding surface of the mold.

Sanson et al does not teach passing a fluid inlet tube through the gasket 13 to blow fluid between the sheets; however, Sanson et al uses a needle to inject his resin adapted to

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enter the enclosure in the parting plane of the die. Since, the gasket 13 is in the parting plane of the die, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to use a needle entering the parting plane of the die through gasket 13 to blow fluid between the upper and lower sheets. Motivation to do so results from the fact that it would be easy to inject a needle for the blowing of fluid through gasket 13 which is an elastomer.

Sanson et al does not disclose forming an aperture in the shell to insert a filling device to pass the foam resin into the shell. Teraoka discloses such an aperture 22. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to form an aperture in the shell of Sanson et al to pass the needle disclosed in column 5, lines 60-65 into the shell to inject the resin in view of aperture 22 of Teraoka. Motivation to do so is the need for such an aperture if resin is going to be injected by the needle of Sanson et al.

The expandable material of Sanson et al is polyurethane.

Sanson et al does not disclose withdrawing the filling device or needle from within the shell as the shell is being filled ; however, this would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains in order to completely fill the shell.



Claim 13 is clearly met by what is shown in figure 4 of Sanson et al.

With regard to claim 14, the mold cavity is heated as is shown in figure 2 of Sanson et al.

Sanson et al does not disclose applying graphics as is claimed in claim 15, nor the sheets as being at least one of polycarbonate, ABS and TPO. Teraoka discloses applying graphics such as small letters to the sheets of material although he doesn't disclose doing this prior to them being inserted into the mold, and Teraoka disclose his sheets of material as, in one instance, being ABS. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to apply graphics such as small letters similar to those of Teraoka to the sheets of Sanson et al prior to them being inserted into the mold. Motivation to do so is to identify the material of the product or the manufacturer of the product. Applying the letters prior to placing the sheets in the mold would not require the mold to be built to have the letters in its inner surface. A savings in cost would result.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to use as the material of the sheets of Sanson et al ABS similar to that used by Teraoka. Motivation to do this is to make a seat pad or cover more rigid in nature.


**Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mizell is cited to show the use of a mold to make a surfboard.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 703-308-1139. The examiner can normally be reached on M-F (6:00-2:30 ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sherman D. Basinger  
Primary Examiner  
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